

Atty. Dkt. No. 035451-0127 (3626.Palm.SG)

### REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

#### Independent Claim 1

With regard to independent claim 1, the Examiner rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Dutta in view of Helms. The Examiner asserts that the second photodetector of Helms located on the backside of a laptop computer LCD display may be combined with the disclosure of Dutta to arrive at Applicants invention recited in claim 1.

Applicants respectfully disagree with the Examiner's assertion. First, neither Dutta, nor Helms provide any motivation to combine the references to arrive at Applicants claimed invention. Applicants claimed invention is for a handheld computer. The disclosure of Dutta does not provide any motivation for combining with Helms, in particular because the second photodetector of Helms is located on the rear side of the display of the laptop. When in normal use, the laptop photodetectors of Helms will both be exposed to ambient light. Not so with a similar configuration on a handheld computer, as a photodetector located on the rear side of a handheld computer will often be obscured, for example, handheld computers are often used laying horizontally on a worksurface or in the palm of a hand such that a photodetector on the rear side would be obscured by the hand or by the worksurface. Accordingly, there is no motivation to combine the teachings of Helms with Dutta, because the teachings of Helms would not provide the needed functionality for a handheld computer display nor is there any desirability provided for making the combination. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Atty. Dkt. No. 035451-0127 (3626.Palm.SG)

Second, neither Helms nor Dutta alone, or in any proper combination discloses, teaches, suggests, or provides any motivation for a combination, for a handheld computer including "at least two light sensors, each light sensor configured to provide input to the computing electronics regarding ambient light conditions at or near the front surface of the display." Helms teaches receiving ambient light conditions by a single detector on the front of the display and a single detector on the rear of the display. The configuration of Helms does not provide ambient light conditions at the front of the display to at least two sensors. Having at least two light sensors providing ambient light conditions on the front of the display is exceptionally important for a handheld device, in that, as described above, any rear-located sensors are often obscured. Also, because a handheld computer is by its nature continually being moved, shadows on a portion of the face of the handheld computer are continuously changing. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Here, multiple sensors providing ambient light conditions on the front of a handheld computer display is not taught or suggested by the references.

Multiple sensors on the face of a handheld computer to adapt to constantly changing lighting conditions on the face of the display is exceptionally important. Further, as Applicants explain on page 8, paragraph [0025] of the specification, a single light sensor for a handheld computer may be obscured by a finger or other object or the like. This is a problem which is not inherent in a laptop computer and is therefore not addressed in Helms and no motivation for such a configuration is provided by Helms.

Accordingly, Applicants respectfully submit that claim 1 and its respective dependent claims are therefore allowable.

#### Independent Claim 8

With regard to independent claim 8, the Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Dutta in view of Helms. The Examiner asserts that the

Atty. Dkt. No. 035451-0127 (3626.Palm.SG)

second photodetector of Helms located on the backside of a laptop computer LCD display may be combined with the disclosure of Dutta to arrive at Applicants invention of claim 8.

Applicants respectfully disagree with the Examiner's assertion. First, neither Dutta, nor Helms provide any motivation to combine the references to arrive at Applicants claimed invention. The disclosure of Dutta does not provide any motivation for combining with Helms, in particular because the second photodetector of Helms is located on the rear side of the display of the laptop. When in normal use, the laptop photodetectors of Helms will both be exposed to ambient light. Not so with mobile devices as a photodetector located on the rear side of many mobile devices will often be obscured, for example handheld computers or mobile phones are often used laying horizontally on a worksurface or in the palm of a hand such that a photodetector on the rear side would be obscured. Accordingly, there is no motivation to combine the teachings of Helms with Dutta, because the teachings of Helms would not provide the needed functionality for a mobile device display.

Second, neither Helms nor Dutta alone, or in any proper combination discloses, teaches, suggests, or provides any motivation for a combination, for a method of controlling a display including receiving light from at least two positions "the first position and the second position are on a same side of the display device." Helms teaches receiving ambient light conditions by a single detector on the front of the display and a single detector on the rear of the display. The configuration of Helms does not provide ambient light conditions at the front of the display to at least two sensors. Having at least the light sensors providing ambient light conditions on the front of the display is exceptionally important for a multiple device such as a mobile phone, or handheld computer, in that, as described above, any rear-located sensors are often obscured. Also, because a mobile device is by its nature continually being moved, shadows on a portion of the face of the handheld computer are continuously changing. Here, multiple sensors on a single side of the device is not taught or suggested by the references.

Accordingly, multiple sensors on the face of a mobile device to adapt to constantly changing lighting conditions on the face of the display is exceptionally important. Further, as

Atty. Dkt. No. 035451-0127 (3626.Palm.SG)

Applicants explain on page 8, paragraph [0025] of the specification, a single light sensor for a mobile device may be obscured by a finger or other object or the like. This is a problem which is not inherent in a conventional laptop computer and is therefore not addressed in Helms and no motivation for such a configuration is provided by Helms.

Accordingly, Applicants respectfully submit that claim 8 and its respective dependent claims are therefore allowable.

Independent Claim 13

With regard to independent claim 13, the Examiner rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Dutta in view of Helms. The Examiner asserts that the second photodetector of Helms located on the backside of a laptop computer LCD display may be combined with the disclosure of Dutta to arrive at Applicants invention of claim 13.

Applicants respectfully disagree with the Examiner's assertion. First, neither Dutta, nor Helms provide any motivation to combine the references to arrive at Applicants claimed invention. The disclosure of Dutta does not provide any motivation for combining with Helms, in particular because the second photodetector of Helms is located on the rear side of the display of the laptop. When in normal use, the laptop photodetectors of Helms will both be exposed to ambient light. Not so with a mobile device as a photodetector located on the rear side of many mobile devices will often be obscured, for example handheld computers and mobile phones are often used laying horizontally on a worksurface or in the palm of a hand such that a photodetector on the rear side would be obscured. Accordingly, there is no motivation to combine the teachings of Helms with Dutta, because the teachings of Helms would not provide the needed functionality for a handheld computer display.

Second, neither Helms nor Dutta alone, or in any proper combination discloses, teaches, suggests, or provides any motivation for a combination, for a method of controlling a display including "the first position, the second position, the third position, and the fourth position are on

Atty. Dkt. No. 035451-0127 (3626.Palm.SG)

a same side of the display device." Helms teaches receiving ambient light conditions by a single detector on the front of the display and a single detector on the rear of the display. The configuration of Helms does not provide ambient light conditions at the front of the display to at least four sensors. Having at least the four light sensors providing ambient light conditions on the front of the display is exceptionally important for a mobile device, in that, as described above, any rear-located sensors are often obscured. Also, because a mobile device is by its nature continually being moved, shadows on a portion of the face of the mobile device are continuously changing.

Accordingly, multiple sensors on the face of a mobile device to adapt to constantly changing lighting conditions on the face of the display is exceptionally important. Further, as Applicants explain on page 8, paragraph [0025] of the specification, a single light sensor for a handheld computer may be obscured by a finger or other object or the like. This is a problem which is not inherent in a laptop computer and is therefore not addressed in Helms and no motivation for such a configuration is provided by Helms.

Accordingly, Applicants respectfully submit that claim 13 and its respective dependent claims are therefore allowable.

Claims 1-17 are now pending in this application.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even

Atty. Dkt. No. 035451-0127 (3626.Palm.SG)

entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date

November 12, 2003

By

Alistair K. Chan

FOLEY & LARDNER  
777 East Wisconsin Avenue, Suite 3800  
Milwaukee, Wisconsin 53202-5306  
Telephone: (414) 297-5730  
Facsimile: (414) 297-4900

Alistair K. Chan  
Attorney for Applicant  
Registration No. 44,603